

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

REDDY ET AL.

Serial No.: **10/759,678**

Filed: **JANUARY 16, 2004**

Title: **"SETTABLE FLUIDS COMPRISING
PARTICLE-SIZE DISTRIBUTION-
ADJUSTING AGENTS AND
METHODS OF USE"**

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Group Art Unit: **1755**

Confirmation No. **8611**

Examiner: **PAUL D. MARCANTONI**

Atty. Docket No: **HES 2003-IP-011937U1**

MAIL STOP AF

Honorable Commissioner of Patents


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PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal and the applicable fee. Applicants respectfully request reconsideration of the application in light of the remarks set forth below.

REMARKS

In a Final Office Action dated July 10, 2008 ("Final Office Action"), the Examiner improperly rejected claims 1-12, 14-28, 30-39, 123-134, 136-170 and 172-191 under 35 U.S.C. § 102(a) and (b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as

obvious over U.S. Patent No. 4,393,939 to Smith *et al.* ("*Smith*"), U.S. Patent No. 3,508,407 to Booth ("*Booth*") alone or in view of U.S. Patent No. 5,588,488 to Vijn *et al.* ("*Vijn*"), U.S. Patent No. 6,087,418 to Yamashita *et al.* ("*Yamashita*"), U.S. Patent No. 6,089,318 to Laramay *et al.* ("*Laramay*"), Scheetz *et al.* (abstract) ("*Scheetz*"), or U.S. Patent No. 4,131,480 to McCurrich *et al.* ("*McCurrich*"). The Examiner maintained these rejections in an Advisory Action dated October 1, 2008 ("Advisory Action"). The rejections of claims 1-12, 14-28, 30-39, 123-134, 136-170 and 172-191 contain clear legal and factual deficiencies.

Independent claims 1, 123 and 159, from which the remainder of the claims depend, have two elements that are salient to this pre-appeal brief: 1) the step of permitting the resulting cement composition to remain in a slurry state for a period of time prior to being activated and 2) the step of activating the cement composition wherein activating the cement composition comprises adding an activator composition to the cement composition. As no combination of references contains these missing elements, the Examiner has failed to make a *prima facie* case of anticipation or obviousness. Thus, independent claims 1, 123, and 159 are allowable over the cited references. Since claims 2-12, 14-28, 30-39, 124-134, 136-158, and 160-170 depend, either directly or indirectly, from claim 1, 123 and 159, these dependent claims are allowable for at least the same reasons.

1. Neither *Smith* nor *Booth* Anticipate Applicants' Claims Because the References do Not Disclose Allowing a Cement Composition to Remain in a Slurry or Activating the Cement Composition.

Smith does not disclose activating the cement composition with an activator composition. Rather, there is no indication or any reference in *Smith* that discloses the addition of an activator composition to the cement composition or allowing the cement composition to remain in a slurry. The main argument by the Examiner focuses on the concept that water acts in "activating" the cement composition. (Final Office Action at 3.) Applicants respectfully disagree because water does not "activate" the Applicants' cement compositions. The specification states that the cement composition may be made ready for use by the addition of activator compositions that "generally comprise a mixture of at least one alkali or alkaline earth metal hydroxide, and a trialkanolamine." (Specification, ¶ [0027]). In addition, water will not activate the cement composition because water is already present in the cement composition as required by the limitation in claims 1, 123, and 159 of "providing a cement composition comprising a

hydraulic cement, a set retarder, *water*, and a particle-size distribution-adjusting agent.” (emphasis added). In the Response to the Fourth Office Action, mailed May 4, 2006, Applicants provided data indicating that the addition of water to a cement slurry has been shown to increase thickening time, *e.g.* retard cement setting. Due to the inclusion of water in the cement composition, it should be clear that some other composition must be used to activate the cement composition after it has been allowed to remain in a slurry state.

With regard to *Booth*, like *Smith*, it has not been shown to disclose a step of activating the cement composition as required by Applicants’ claims 1, 123 and 159. Rather, there is no indication or any reference in *Booth* that discloses the addition of an activator composition to the cement composition as water is not an activator within the scope of claims 1, 123, or 159.

Furthermore, whether or not the water may be considered the claimed activator as alleged by the Examiner, the Examiner has not shown that either *Smith* or *Booth* disclose a step of “permitting the cement composition to remain in a slurry state” for any period of time. Nothing in either of these references discloses or suggests that a cement composition remains in slurry state. Accordingly, Applicants respectfully assert that neither *Smith* nor *Booth* has not been shown to anticipate Applicants’ independent claims 1, 123 and 159.

Consequently, for at least the above stated reasons, Applicants respectfully submit that claims 1, 123 and 159 are not anticipated by either *Smith* or *Booth*.

2. *Smith* and *Booth*, Either Alone or in Combination, in View of *Vijn*, *Yamashita*, *Laramay*, or *Scheetz* Do Not Obviate Applicants’ Claims Because None of the Sources Disclose Allowing the Cement Composition to Remain in a Slurry or Activating the Cement Composition

Examiner has not established a *prima facie* case of obviousness, in that the cited references do not disclose, expressly or inherently, each and every claim limitation and there is no teaching or suggestion to combine the references. MPEP § 2143.03 (2005). In order for a combination of references to form the basis for a rejection under § 103(a) the combination of references must teach or suggest all the elements of the claim. *Id.* The Examiner has failed to establish a *prima facie* case because none of the references cited disclose the elements of “permitting the cement composition to remain in a slurry state” or “wherein activating the cement composition comprises adding an activator composition to the cement composition.”

Examiner has relied on the disclosure of water in the references to constitute an activator. As discussed above, water cannot be an activator within the scope of claims 1, 123, or 159.

As discussed above, neither *Smith* nor *Booth* discloses the limitations at issue in claims 1, 123, or 159. Therefore, neither *Smith* nor *Booth* can form the basis for a *prima facie* case of obviousness with respect to these limitations.

Vijn also fails to teach or suggest the missing limitations. Rather, *Vijn* discusses the use of set retarders “to extend the time in which the cement slurry composition can be pumped” and discloses the ability to retard activated cement compositions. However, the use of a set retarder in an activated cement does not teach or suggest allowing a cement composition to remain in a slurry or activating the cement composition after it has been in a slurry.

With respect to *Yamashita*, it does not teach or suggest all elements of Applicants’ independent claims 1, 123 and 159. *Yamashita* teaches high-early-strength agents and promoters, which teach away from the steps of the claimed invention. Specifically, *Yamashita* discloses adding these compounds to the cement in order to generate high early strength which is opposed to the step of “permitting the cement composition to remain in slurry state for a period of time prior to the cement composition being activated.” Developing a high early strength soon after preparation would prevent the cement composition from remaining in a slurry state for a period of time. As such *Yamashita* does not disclose allowing the cement to remain in a slurry for a period of time prior to activation or activating the cement composition.

With respect to *Laramay*, it nowhere discloses allowing the cement composition to remain as a slurry or activating the cement composition. *Laramay* discloses that an accelerator may be used as an additive but does not discuss any activators. As stated in Applicants’ Amendment and Response to Office Action dated May 7, 2007, one of ordinary skill in the art would recognize a functional difference in that the term “accelerator” is generally used to refer to a particular composition that is added to a cement composition not comprising a set retarder, while the term “activator” is generally used to refer to the same composition when it is added to a cement composition comprising a set retarder. As disclosed in *Laramay*, an accelerator may be used with a cement composition to which a retarder may be added. *Laramay* Col. 10, ll. 25-30, 40-49. However, inclusion of a retarder in a cement composition containing an accelerator does not disclose allowing the cement composition to remain in a slurry state or “activating the cement composition” after it has been in a slurry state.

Further, Examiner cites *Scheetz* and *McCurich* for disclosing yield stress reducing agents and not for disclosing either of the missing limitations. Consequently, for at least the above stated reasons, Applicants respectfully submit that claims 1, 123 and 159 are not anticipated or obviated by any of the cited references, individually or in any combination.

CONCLUSION

Since claims 2-12, 14-28, 30-39, 124-134, 136-158, 160-170 and 172-191 depend, either directly or indirectly, from claims 1, 123 and 159, these dependent claims are allowable for at least the reasons cited above. *See* 35 U.S.C. § 112 ¶ 4 (2005). Accordingly, Applicants respectfully request the withdrawal of these rejections.

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same.

Applicants believe that there are no fees due in association with this Request. However, should the Commissioner deem that any additional fees are due, including any fees for extensions of time, the Commissioner is authorized to debit Baker Botts L.L.P.'s Deposit Account No. 02-0383, Order Number 063718.0359, for any underpayment of fees that may be due in association with this filing.

Respectfully submitted,

Respectfully submitted,

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